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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,820	03/31/2004	James Phillip Hollandsworth	030627/274121	5314

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ALSTON & BIRD LLP  
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101 SOUTH TRYON STREET, SUITE 4000  
CHARLOTTE, NC 28280-4000

EXAMINER
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DEXTER, CLARK F

ART UNIT	PAPER NUMBER
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3724

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/18/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

10/814,820

**Applicant(s)**

HOLLANDSWORTH ET AL.

**Examiner**

Clark F. Dexter

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4 and 6-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4 and 6-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 8, 2006 has been entered.

### ***Drawings***

2. The drawings were received on May 19, 2006. These drawings are NOT acceptable. It is respectfully submitted that sufficient support could not be found in the original disclosure to support the addition of new Figure 5. If applicant's position is that the structure shown in Figure 5 is known in the art, then the drawing should be labeled "Prior Art" and the specification should be amended to provide such a statement.

3. The drawings stand objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the subject matter set forth in claim 5 (e.g., a non-contiguous ring defining an angular gap, and a fastening device capable of operably engaging the collar across the gap), and a threaded radially-outward surface as set forth in claim 8 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112, 1<sup>st</sup> paragraph***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 8-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to

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which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The original disclosure does not provide sufficient support for a threaded radially-outward surface as set forth in claim 8 in conjunction with the other claimed features, and thus it is not clear as to what is disclosed and as to how the apparatus having such a feature operates.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chapman, pn 2,236,366 in view of the admitted prior art (APA).

Chapman discloses a splitter device with almost every structural limitation of the claimed invention including

a first rotatable shaft (e.g., 5) extending axially through a first cutting blade (e.g., 31);

a second rotatable shaft (e.g., 3) disposed substantially parallel to the first rotatable shaft; and

a second cutting blade (e.g., 28) having the second rotatable shaft extending axially therethrough, the second cutting blade being axially movable relative to the

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second rotatable shaft such that the second cutting blade can be adjusted to maintain a cutting position adjacent to the first cutting blade so as to compensate for blade wear; and further comprising a collar (e.g., 29) having the second rotatable shaft extending axially therethrough, the collar being configured to be capable of fixedly engaging the second rotatable shaft so as to axially fix the second cutting blade with respect to the second rotatable shaft; and further comprising at least one securing member (e.g., 30) capable of operably engaging the collar so as to secure the collar to the second rotatable shaft, wherein the securing member comprises a fastening device (e.g., 30) configured to be capable of extending radially through the collar so as to provide a fixed engagement between the collar and the second rotatable shaft; and wherein at least one of the first and second cutting blades is substantially circular in profile.

Chapman discloses that the first blade is resiliently mounted and thus lacks the second cutting blade being in a fixed spaced relationship from the first cutting blade as now set forth in claim 1. However, Chapman teaches (e.g., see col. 1, lines 24-29) that prior art disks "mounted rigidly in axial relation to each other to assure a suitable cutting of the paper." That is, such a configuration is well known and could be considered a step backwards in the art. Therefore, it would have been obvious to one having ordinary skill in the art to simply provide the known, prior art upper disk configuration wherein the disk is rigidly mounted to the upper or first rotatable shaft to provide various well known benefits including a simpler device that is easier to assemble and use as well as being less expensive to acquire and maintain.

Further, Chapman lacks a collar that comprises a non-contiguous ring as claimed. However, as admitted by applicant (in remarks of the subject amendment), such collar configurations are known in the art and therefore would have been an obvious modification to Chapman to gain the well known benefits including facilitating fixing the collar in position and releasing the collar.

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chapman et al., pn 2,236,366 in view of the APA as applied to claim 1 above, and further in view of Schillo, pn 1,856,433.

Chapman discloses a slitter device with almost every structural limitation of the claimed invention but lacks at least one of the first and second cutting blades being non-circular in profile. However, such blade configurations are old and well known in the art and provide various well known benefits including "missed cuts" for perforating a workpiece. Schillo discloses one example of such a cutter configuration. Therefore, it would have been obvious to one having ordinary skill in the art to replace the blade of Chapman with a blade having the configuration of Schillo to gain the well known benefits including that described above.

***Claims Not Rejected Over Prior Art***

9. Claims 8-10 set forth structure that does not appear to be taught or suggested by the prior art of record. However, these claims cannot be considered to be allowable because they are not understood and/or are not sufficiently supported in the disclosure as described above.

***Response to Arguments***

10. Applicant's arguments with respect to claims 1, 4, 6 and 7 have been considered but are moot in view of the new ground(s) of rejection.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571)272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**Clark F. Dexter**  
**Primary Examiner**  
**Art Unit 3724**

cf  
January 8, 2007